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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,951	02/28/2000	STEPHEN JAMES DAVIS	8697-001-27P	3194

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MCKENNA LONG & ALDRIDGE LLP  
1900 K STREET, NW  
WASHINGTON, DC 20006

EXAMINER
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CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/446,951**

Applicant(s)  
**Davis**

Examiner  
**Michael Cuff**

Art Unit  
**3627**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 29, 30, 32, 36, and 37 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 29, 30, 32, 36, and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3627

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of the restriction requirement in Paper No. 27 is acknowledged. The traversal is on the ground(s) that there is unity of the invention and that there exists a technical relationship. This is not found persuasive because the examiner has applied the proper "species are deemed to lack unity of invention" rules for a national stage application under 35 USC 371 and applicant's claims fail to meet the criteria set forth by 37 CFR 1.475.

Supporting explanation was provided in section 5 of paper 28, mailed 9/9/02.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the vehicle (positively recited, claim 1, line 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 3627

3. Per the drawing objections made in this office action, corrected drawings are required in reply to this office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. If the reply does not include corrected drawings or a reply to the drawing requirements, the reply should be held non-responsive.

The above new guidelines are set forth in:

*Changes to Implement Eighteen-Month Publication of Patent Applications*; Final Rule,  
65 Fed. Reg. 57023 (Sept. 20, 2000)

*Drawings in Patent Application Publications and Patents*, 1242 Off. Gaz. Pat. Office 114  
(Jan. 16, 2001)

The Memorandum on "Procedures for Treatment of Drawings in Utility Applications"  
from Esther M. Kepplinger, Deputy Commissioner for Patent Operations, on May 3, 2001 to  
Patent Examining Corps Directors.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3627

Claim 1, lines 4-5, broadly recites “the hitch assembly”, it is not clear from the specification or the drawings what the scope of this term is. As best understood, based on the specification and the embodiment chosen, “the hitch assembly” is the hitch ball 83 and nut 84.

Claim 1, line 1, recites “A step apparatus including:”. Lines 2-3, recite “adapted to” language in order to not positively recite a vehicle or a hitch assembly. Lines 4-7, abandons the “adapted to” language and positively recite limitations of the step which include “a hitch portion”, “the hitch assembly”, “a vehicle hitch”, “a rear portion of a vehicle” and “the hitch”. It is unclear whether the combination of the step and parts of the vehicle or the subcombination of the step is being claimed. The preamble is directed to the subcombination of a step, but the body of the claims further recites structure of the combination of the step and parts of the vehicle. The claims should be amended to positively include the vehicle or include functional language such as “adapted to”, “having the capability to” or “for attachment to” when referring to the parts of the combination. For examination purpose, the claims will be treated as if the combination of the step and parts of the vehicle is being claimed.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

Art Unit: 3627

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1, 29, 30, 32, 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Mason.

Mason shows, figure 2, a trailer hitch locking assembly with an upper receiver 26 (step, step portion) which has a first and second positions as it is pivotally secured (hinged) to the mounting plate 12 (mounting portion). There is a mounting aperture 14 which allows the assembly to be secured to the vehicle by means of a hitch ball 16 and nut (hitch assembly). The closed position (first position, above hitch ball) does not allow the hitch to leave or enter the assembly once locked. The upper receiver has an open position (second, stowed position). There is a portion of the upper receiver, in both positions, which is forward of a portion of the hitch ball and adjacent to a rear portion of the vehicle.

### ***Response to Arguments***

8. Applicant's arguments filed 5/7/02 have been fully considered but they are not persuasive.

Due to the restriction requirement and subsequent election, the arguments regarding the 35 USC 112, 1st rejection are moot.

Applicant assert that claim 1 requires that the step in its entirety may be moved to a second stowed position adjacent to a rear portion of the vehicle and forward of the hitch. The examiner does not concur. Applicant is arguing limitations which are not in the claim. For example, "in its entirety" is not in the claim. Additionally, "adjacent to a rear portion of the

Art Unit: 3627

vehicle” limitation does not carry much weight since applicant does not even show a vehicle. The entire Mason apparatus is adjacent to the rear of a vehicle as shown in figure 1.

Applicant asserts that the claim language has the implication that the step portion must move in a forward direction to stow. The examiner does not concur. Applicant may try to imply limitations, but the fact is that the above limitation is not in the claim.

Applicant asserts that Mason does not teach or suggest the step portion in a first position above the vehicle hitch and a second stowed position forward of the hitch. The examiner does not concur. The Mason upper receiver (step portion) surrounds the hitch ball, therefore part of the upper receiver is forward of the hitch.

Applicant asserts that Mason does not teach or disclose a step portion that can be used with or without the hitch being used. The examiner does not concur. Mason’s figure 1 shows the apparatus with a hitch and figure 3 shows the apparatus without a hitch.

### ***Conclusion***

9. Any inquiry concerning this communication should be directed to Michael Cuff at telephone number (703) 308-0610.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113. The fax

Application/Control Number: 09/446,951

Page 7

Art Unit: 3627

phone number for this Group is (703) 872-9326. (After Final special fax number (703) 872-9327)

The customer service number is (703) 872-9325.

 12/27/02  
Michael Cuff  
December 27, 2002